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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,197	09/21/2001	Modest Khovaylo	10010566-1	4589

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
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EXAMINER
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SAFAIPOUR, HOUSHANG

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/960,197

Applicant(s)

KHOVAYLO ET AL.

Examiner

Houshang Safaipoor

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35, 38-44 and 46 is/are rejected.
- 7) ☒ Claim(s) 36, 37 and 45 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's amendment filed on November 21, 2005 has been entered and made of record.

Applicant's arguments have been considered, but are moot in view of the new grounds of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent claims mentioned above recite "scanning an electrical image of an item". The underlined term is indefinite.

Accordingly, independent claim 1 and its dependent claims have not been treated on the merits.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 33-35, 38, 39, 42-44 and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Neushul (U.S. Patent No. 6,208,437).

Regarding claim 33, Neushul discloses a method for displaying and scanning an item, said method comprising the steps of:

supporting said item to be scanned, generally upright in a frame (figs. 1 and 3, col. 2, lines 15-21);

retaining said item within said frame for display and scanning (col. 1, line 59 through col. 2, line 6); and

scanning an electronic image of said item into memory storage (col. 2, line 66 through col. 3, line 2).

Regarding claim 34, Neushul discloses the method of claim 33 wherein said scanning step further comprises the step of selectively initiating said scanning (col. 2, line 66 through col. 3, line 2).

Regarding 35, Neushul discloses the method of claim 33 wherein said scanning step further comprises the step of storing said electronic image in remote memory storage (col. 2, lines 66 through col. 3, line 2).

Regarding claim 38, Neushul discloses the method of claim 33 further comprising the step of displaying an electronic image when an item is not disposed in said frame (image can be displayed on computer monitor when retrieved from computer file (col. 3, line 6).

Regarding claim 39, Neushul discloses the method of claim 33 further comprising the step of: disposing said item to be scanned in said frame facing outward (fig. 3).

Regarding claims 42-44 and 46, arguments analogous to those presented for claims 33-35 and 38 are applicable to claims 42-44 and 46 respectively.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neushul (U.S. Patent No. 6,208,437) and further in view of Takeuchi (U.S. Patent No. 6,057,944).

Regarding claim 40 Neushul does not explicitly disclose initiation of scanning with a wireless device. Takeuchi discloses such capability in his image scanning device (col. 8, line 67 through col. 9 line 5). Therefore it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to include this feature in Neushul scanning for remote wireless operation of the scanner.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neushul (U.S. Patent No. 6,208,437) and further in view of Krist et al. (U.S. Patent No. 5,615,015).

Regarding claim 41 Krist et al. discloses remote image processing operation which include image rotation (col. 10, lines 53-63). Therefore it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to include this image processing feature in Neushul's scanning operation to add remote capabilities to Neushul's system.

#### ***Allowable Subject Matter***

Claims 36, 37 and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Thurs. from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles, Sr. can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Houshang Safaipoor  
Patent Examiner  
Art Unit 2622  
February 4, 2006

*Ed. M. M.*